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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/522,434 | 03/09/2000 | Feng-Nien Ko | 11544-003001 | 3204 |
| 26161 | 7590 | 10/31/2003 | EXAMINER | |
| FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110 | | | COE, SUSAN D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1654 | |

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/522,434 | KO ET AL. | |
| | Examiner | Art Unit | |
| | Susan Coe | 1654 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 August 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-5,7-9 and 12-37 is/are pending in the application.
- 4a) Of the above claim(s) 3-5,7-9 and 12-37 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed August 8, 2003, has been received and entered. The declaration filed on the same day has been considered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claims 1, 3-5, 7-9, and 12-37 are pending.

Election/Restrictions

3. Applicant states that claims 3 and 23-37 have never been withdrawn from consideration; however, as explained in the previous Office action, these claims are not considered to read on the elected species. See page 2 of the previous Office action.
4. Claims 3-5, 7-9, and 12-37 are withdrawn from consideration as being drawn to non-elected invention and species.
5. Claims 1 and 11 are examined on the merits.

Claim Rejections - 35 USC § 102

6. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4,317,816 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the reference does not contain ether soluble components while the claimed extract does contain these components. Applicant's argue that the declaration of Mr. Feng-Nien Ko supports this point. However, applicant is arguing limitations that are not in the claim. The claim only states that the American ginseng

composition is a solvent extract that has been filtered so that no components of less than 1,000 molecular weight are present in the composition. The reference teaches a solvent extract of American ginseng that has isolated components of more than 1,000 molecular weight. Therefore, the composition of the prior art meets the limitations of applicant's claims.

7. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Derwent English abstract of JP 04316507 A for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the reference does not anticipate the claimed invention because the reference teaches using a filter with a molecular weight cutoff of 10,000 while Yoshikawa teaches that American ginseng extracts only have molecular weights between 1,000 and 10,000. However, Yoshikawa is not the reference that this rejection is based on. Since this reference is not directly used in any rejection made by the examiner, the examiner assumes that applicant is arguing that Yoshikawa shows that the JP '507 is not enabled. However, JP '507 clearly sets out extraction steps that would lead to an American ginseng extract that only has molecular weight components of over 10,000. The reference tests this composition and shows that it has pharmaceutical effects; therefore, the American ginseng extract of JP '507 contains pharmaceutically active components that are above 10,000 molecular weight. Therefore, the composition of JP '507 anticipates applicant's claim 1 because it is an American ginseng extract that consists essentially of a preparation that is extracted with a solvent and then ultrafiltered with a membrane of 10,000 (applicant's claim states that the cut off is **at least** 1,000) to yield the extract.

8. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by English abstract of JP 61109732 A for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant traverses this rejection for the same reasons stated for the rejection based on JP '507. Therefore, the argument is not persuasive for the reasons stated above.

9. No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

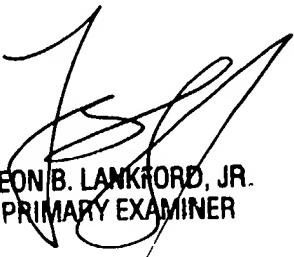
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The

examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Susan Coe, Examiner
October 30, 2003



LEON B. LANKFORD, JR.
PRIMARY EXAMINER